REMARKS

Claims 1-4, 6-21, and 23-33 are currently pending in this Application. Claims 1, 2, 4, 6-13, 15-21, 23-27, and 29-33 are currently amended. Claims 3 and 14 were previously amended. Claim 28 was previously added by amendment and remains unchanged. Claims 5 and 22 were previously cancelled by the applicant without prejudice. Reconsideration of the Application is respectfully requested.

I.   Summary of November 17, 2004 Examiner Interview

The undersigned thanks Examiners Shar and Sain for the courtesies extended during the telephone interview of November 17, 2004. No agreement was reached as to any issues discussed.

The telephone interview was requested by the undersigned for the primary purpose of discussing the teachings of several references cited in the Office action, as well as the motivation to combine various references used in the Office action to support obviousness rejections under 35 U.S.C. § 103(a).

Specifically, it was argued by the undersigned that the step of "generating a comparison result file" is not taught by any of the cited references. The Examiners explained that, giving this claim language its broadest possible interpretation, they construes this language to include the act of performing the comparison. It was further added that, if this language is to be limited so as to require displaying the results to a user or storing the results in a computer-readable medium, then the claim language must be narrowed to include that limitation.

The term "groups of characters" was construed by the Examiners to include any individual word. The Examiners explained that this term would need to be narrowed if the Applicant desires for it to refer to some more specific level of grouping of characters. The Examiners also explained that they are construing the term "line-by-line comparison" as used in the claims to include any segment of characters.

Finally, the undersigned pointed out that the Office action employs several combinations of four and five references to make obviousness rejections and, in some of the obviousness rejections, there seems to be insufficient motivation to combine the

references. The Examiners stated that they consider any art relating to displaying text to be analogous art.

II.   Rejections under 35 U.S.C. § 101

All pending claims stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. For the reasons set forth below, these claims are now in condition for allowance.

All claims[1] currently pending in the Application have been amended to make abundantly clear what was previously implicitly clear: that the steps of the method are implemented by or with the assistance of a computer or a computerized device or system. With this amendment, there can be no question that tangible media within the technological arts are called upon to carry out the steps of the method in a non-trivial way.

With regard to claims 1, 8, 12, 26, and 33, the Office action additionally contends that these claims merely require the manipulation of data within a computer and do not display any results or require any user intervention. These claims have been amended to make clear that generating a comparison result file includes at least one of the computer-implemented steps of displaying the comparison result file to a user and storing the comparison result file in a computer-readable storage medium.

Applicant submits that all pending claims are allowable under 35 U.S.C. § 101 and respectfully requests that the rejection of record be withdrawn.

III.   Rejections Under 35 U.S.C. § 103(a)

A.   Claims 26-33

The Office action contends that claims 26 and 33 are obvious from Aiken in view of Popp. For the following reasons, these rejections are respectfully traversed.

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[1] The only claims that are not currently amended are claims that depend from claims that are currently amended. Accordingly, all claims now provide that the steps are implemented by or with the assistance of a computer or a computerized device or system.

Claims 26 and 33[2] include the steps of "detecting corresponding groups of characters in the left and right files" and "comparing a group in the right file to a corresponding group in the left file . . ." These claims specify how the groups of characters are detected:

> . . . the detecting step including the step of scanning the respective file for a group of characters, each of which begins with a block-level HTML tag, wherein block-level HTML tag is an HTML tag that breaks the flow of text when an HTML document is rendered.

This step is not taught by any of the cited art. Contrary to the Office action's contention, Popp does not teach this step. While Popp does teach the use of HTML tags to break the flow of text in an HTML document, this reference contains no mention or suggestion of using HTML tags to "detect[] corresponding groups of characters in the left and right files" and "compare[e] a group in the right file to a corresponding group in the left file," as required by claims 26 and 33. The use of HTML tags in this way is completely absent from the cited references, and the references provide no suggestion or motivation to combine their teachings regarding HTML tags with the detection and comparison steps of claim 26. Accordingly, claims 26 and 33 are not obvious from the cited references.

Claims 27 through 32 all depend from claim 26 and are therefore allowable for the same reasons as stated above regarding claim 26.

B.   Claims 1-25

1.   These claims are allowable in light of Applicant's Amendments

Each of claims 1 through 25 includes the step of "generating a comparison result file." The Office action contends that Aiken teaches this step because FIG.6 of Aiken shows a window containing the results of a document comparison that can be displayed to the user. Each of these claims in the present application has been amended, either directly or by amendment of a base claim from which it depends, to provide that this step of generating a comparison result file includes at least one of the computer-implemented steps of: (a) displaying the comparison result file to a user, and (b) storing the comparison

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[2] Claims 26 and 33 contain the same steps; the only difference between these claims is that claim 33 is an apparatus claim written in means-plus-function format pursuant to 35 U.S.C. § 112, paragraph 6.

result file in a computer-readable storage medium. Aiken makes no mention or suggestion of storing the comparison result file in a computer-readable medium. Accordingly, these claims, as amended, are not obvious from the cited art and are in condition for allowance.

2. **The Office action impermissibly combines isolated teachings of numerous references to construct a 'creeping' obviousness argument that is based on hindsight reconstruction**

Additionally, for many of the rejections of record, the Office action draws upon combinations of <u>four</u> references (¶2-3, Claims **3, 14, 16, 17, 19, 20**; ¶2-4, Claim **7**; ¶2-13, Claim **29**; ¶2-14, Claim **30**; and ¶2-15, Claim **31**) and <u>five</u> references (¶2-10, Claim **18**). Applicant respectfully submits that there is insufficient motivation to combine such a great number of references and use their independent teachings in combination to make an obviousness rejection. A person of ordinary skill in the art would not find motivation to combine all these individual teachings to modify the cited art to reach the invention claimed in the present application. A combination of individual teachings from so many different references simply is not obvious to persons skilled in the art.

The Office action employs a 'creeping' obviousness argument to reject each claim in a series of progressively narrower claims by essentially contending that each claim is obvious from the previous claim. For example, the Office action rejects claim 1 as obvious from U.S. Patent No. 6,658,626 ("Aiken") in view of U.S. Patent No. 5,717,945 ("Tamura"). The Office action then rejects claim 2, which depends from claim 1, as obvious from the combination of Aiken and Tamura in further view of U.S. Patent No. 5,956,726 ("Aoyama"), contending that Aoyama teaches the additional element in claim 2. The Office action then rejects claim 3, which depends from claim 2, as obvious from the combination of Aiken and Tamura and Aoyama in further view of U.S. Patent No. 6,651,108 ("Popp"), contending that Popp teaches the additional element in claim 3.

This patchwork assembly of references to supply individual missing elements in the series of claims has been rejected by the Federal Circuit: "We cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Ecolochem, Inc. v. Southern California Edison Company*, 227

F.3d 1361, 1371 (Fed. Cir. 2000) (*citing In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596 (Fed. Cir. 1988)). The *Ecolochem* court counseled that "the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references." *Id.* Thus, "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *Id.* at 1372 (quote from *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

There is not sufficient motivation to combine the individual teachings of the references in the Office action's 'creeping' obviousness argument. Regarding the rejection of claim 3, for example, the Office action states:

> It would have been obvious to one of ordinary skill in the
> art at the time of the invention to modify Aiken in view of
> Tamura and Aoyama to include block of HTML statements
> as taught by Popp, providing the benefit of one-to-one
> mapping between each HTMO [sic] element and object
> classes . . . to manipulate the HTML element within an
> HTML document (Popp, Abstract).

(Office action, ¶2-3). The Office action's argument apparently goes something like this: If it would have been obvious to modify Aiken with Tamura to supply one of the elements of claim 1, and if it would have been obvious to modify this combination of Aiken and Tamura with Aoyama to supply the additional element of claim 2, then it would have been obvious to modify the combination of Aiken and Tamura and Aoyama with Popp to supply yet another added element in claim 3. This 'creeping' obviousness argument essentially piggybacks on the earlier claims to find each new addition to be "obvious." This bootstrapping on prior claims is a clear instance of "hindsight reconstruction" that runs afoul of the Federal Circuit's pronouncement that a claim must be obvious from the prior art, not from other claims in the application, in order to be rejected under 35 U.S.C. § 103(a). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of motivation to combine the references. *Ecolochem*, 227 F.3d at 1372 (*citing In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir.1999)).

14

Additionally, the *Ecolochem* court explained that "[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *Id.* at 1372 (*quote from Monarch Knitting Mach. Corp. v. Sulzer Morat Gmbh,* 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed.Cir.1998)). This, however, is precisely what the Office action does when it states the purported motivation to combine the references. In the excerpt quoted above, the Office action contends that it would have been obvious to combine the references because the combination would "provid[e] the benefit of one-to-one mapping between each HTMO [sic] element and object classes . . . to manipulate the HTML element within an HTML document." This is simply a statement of the problem to be solved by the invention. Accordingly, the Office action has failed to set forth any actual motivation "in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination," as required by the Federal Circuit. *Ecolochem,* 227 F.3d at 1372 (*quote from In re Beattie,* 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed.Cir.1992) and *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.,* 730 F.2d 1452,1462, 221 USPQ 481, 488 (Fed. Cir. 1984)).

For these reasons, the rejections of claims 3, 7, 14, 16, 17, 19, 20, 29, 30, and 31 should be removed. Applicant respectfully submits that these claims are in condition for allowance.
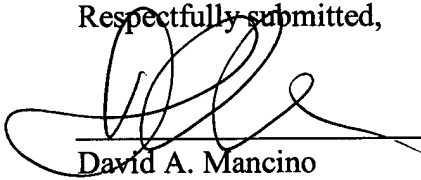
IV.   Conclusion

In light of the foregoing, it is respectfully submitted that claims 1-4, 6-21, and 23-33, now pending as amended, are distinguishable from the references cited and in condition for allowance. Reconsideration and withdrawal of the rejections of record is respectfully requested.

If the Examiner wishes to discuss any aspect of this response, please contact the undersigned at the telephone number provided below.

Applicant hereby requests a one-month extension of time and authorizes the Commissioner to charge any fees that may be required by this paper, or to credit any overpayment to Deposit Account 50-3072.

Respectfully submitted,

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